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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109

In re Application of
HOULBERG et al
U.S. Application No.: 10/586,325
PCT No.: PCT/DK2005/00027
Int. Filing Date: 17 January 2005
Priority Date: 16 January 2004
Attorney Docket No.: 58982.000040
For: METHOD AND SYSTEM FOR
COLORIMETRIC DETERMINATION OF
A CHEMICAL OR PHYSICAL
PROPERTY OF A TURBID

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 05 September 2007.

BACKGROUND

On 05 February 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 05 September 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition, the surcharge fee, a five-month extension and fee, a declaration signed by two named inventors, an affidavit by Klaus Bach Hagen, assorted documentary evidence, and authorization to charge any additional fees which may be required to Deposit Account No. 50-0206.

DISCUSSION

Applicants claim that joint inventor Joseph Sturino refuses to cooperate in the above-identified application and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 05 February 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a

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statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the petition fee has changed to \$200.00. Applicants submitted a \$130.00 petition fee. The \$70.00 difference has been charged to Deposit Account No. 50-0206 as authorized.

With regards to item (3), the last known address of Joseph Sturino is listed as:

4403 Spring Branch Court
College Station,
TX 77845

Concerning item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by two of the three co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of all three inventors are recorded on the declaration. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are complete.

Regarding item (2), the 37 CFR 1.47(a) applicants' submitted a declaration by Mr. Hagen who details his correspondence with co-inventor Joseph Sturino and that he received no response despite his efforts. This conduct would be sufficient to show a refusal to cooperate pursuant to section 409.03(d) of the MPEP if the nonsigning inventor was presented with a complete copy of the subject application also. However, applicants have not demonstrated that a complete copy of the application including specification, claims and drawings were presented to the nonsigning inventor.

The statement by Mr. Hagen that they "previously forwarded a copy of the patent application in caption to Joseph Sturino" is insufficient without direct documentary evidence of the nonsigning inventor's receipt. Further, the evidence submitted shows that Mr. Hagen sent only a copy of the declaration and assignment to the nonsigning inventor. Moreover, the emails referencing documents previously forwarded by Elisabeth Matthes is also insufficient to show receipt by Mr. Sturino. Applicants must provide documentary evidence that a complete copy of the subject application, including specification, claims and drawings were **forwarded and received** by the nonsigning inventor.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

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CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter deposited with the USPS should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents marked to the attention of the Office of PCT Legal Administration.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302